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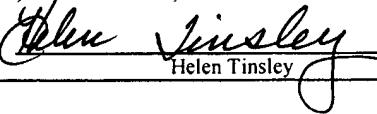|		
In re Application of:	§	
Edward Panelli et al.	§	
	§	Group Art Unit: 3625
Serial No.: 09/682,574	§	
	§	Examiner: Haq, Naeem U.
Filed: September 21, 2001	§	
	§	
For: STANDING ORDER SYSTEM AND	§	Atty. Docket: GEMS:0112/YOD
METHOD	§	15EC5739

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Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF PURSUANT TO 37 C.F.R. §§ 41.31 AND 41.37

This Appeal Brief is being filed in furtherance to the Notice of Appeal mailed on July 7, 2006, and received by the Patent Office on July 12, 2006.

The Commissioner is authorized to charge the requisite fee of $500.00, and any additional fees which may be necessary to advance prosecution of the present application, to Account No. 07-0845, Order No. 05739P-2/YOD (GEMS:0112).

Appellants hereby request a one (1) month extension in the statutory period for submission of the Appeal Brief, from September 12, 2006 to October 12, 2006, in accordance with 37 C.F.R. § 1.136. The Commissioner is authorized to charge the requisite fee of $120.00, and any other fee that may be required, to Deposit Account No. 07-0845; Order No. 05739P-2/YOD (GEMS:0112).

1. **REAL PARTY IN INTEREST**

The real party in interest is General Electric Company, the Assignee of the above-referenced application by virtue of the Assignment to General Electric Company recorded at reel 012711, frame 0783, and dated March 14, 2002. Accordingly, General Electric Company will be directly affected by the Board's decision in the pending appeal.

2. **RELATED APPEALS AND INTERFERENCES**

Appellants are unaware of any other appeals or interferences related to this Appeal. The undersigned is Appellants' legal representative in this Appeal.

3. **STATUS OF CLAIMS**

Claims 1-9, 11-16 and 30-37 are currently pending, are currently under final rejection and, thus, are the subject of this Appeal.

4. **STATUS OF AMENDMENTS**

There are no outstanding amendments to be considered by the Board.

5. **SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention relates generally to a system and method for creating and managing a standing order, and more particularly, to a system and method to enable a customer to electronically create a standing order with a supplier, the standing order directing the supplier to periodically provide the customer with a desired quantity of products, goods and/or services at a desired frequency of delivery. *See id.* at paragraph 2.

The Application contains 3 independent claims, namely, claims 1, 19 and 30, all of which are the subject of this Appeal. The subject matter of these claims is summarized below.

With regard to the aspect of the invention set forth in independent claim 1, discussions of the recited features of claim 1 can be found at least in the below cited

locations of the specification and drawings. By way of example, an embodiment in accordance with claim 1 provides an electronic information system (*e.g.*, 64), wherein the electronic information system is accessible electronically via an electronic communication system (*e.g.*, 68, 70, 72). *See, e.g., id.* at paragraph 38; *see also* Fig. 3. The electronic information system is operable to enable a customer (*e.g.*, 66) to access the electronic information system via the electronic communication system to electronically create a standing order (*e.g.*, 118) electronically, of a customer specified duration (*e.g.*, 120) for periodic delivery to a specified customer location of a product, good, or service. *See, e.g., id.* at paragraphs 38-40; paragraphs 46-48; *see also* Figs. 3, 6 and 7.

With regard to the aspect of the invention set forth in independent claim 19, discussions of the recited features of claim 19 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in accordance with claim 19 provides a computer program stored in a tangible medium, wherein the computer program enables an electronic information system (*e.g.*, 64) to enable a customer to access the electronic information system. *See, e.g., id.* at paragraph 38; *see also* Fig. 4. Further, the computer program enables the electronic information system to enable a customer to input electronically a desired product, good, or service for periodic delivery to a specified customer location under a standing order (*e.g.*, 118) of a customer specified duration (*e.g.*, 120). *See, e.g., id.* at paragraphs 46-48; *see also* Figs. 6 and 7.

With regard to the aspect of the invention set forth in independent claim 30, discussions of the recited features of claim 30 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in accordance with claim 30 provides a system, comprising a memory, and computer program stored in the memory. *See, id.* at paragraph 38; *see also* Fig. 3. The system further comprises a processor coupled to the memory, the processor operating in response to the computer program stored in the memory. *See, e.g., id.* at paragraphs 38-39; *see also*

Fig. 3. Further, the system comprises an electronic communication system (*e.g.*, 68, 70, 72) coupled to the processor. *See, e.g., id.* at paragraphs 38-39; *see also* Fig. 3. The computer program enables a customer to access the system electronically via an electronic communication device and create a standing order (*e.g.*, 118) of a customer specified duration (*e.g.*, 120) for a quantity of a product, good, or service for delivery to a customer specified location by a supplier on a periodic basis. *See, e.g., id.* at paragraphs 46-48; *see also* Figs. 6 and 7.

A benefit of the invention, as recited in these claims, is the ability to reduce or eliminate the problems associated with conventional methods of creating standing orders. More specifically, the method and system recited by the claims enable a customer to create and manage standing orders electronically using an information system, such as the Internet. This is a clear difference and distinction from the prior art, as discussed below.

6. **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. **First Ground of Rejection for Review on Appeal:**

Appellants respectfully urge the Board to review and reverse the Examiner's first ground of rejection in which the Examiner rejected claims 1-9, 11, 14-16, 19-24, 30-33, and 35-37 under 35 U.S.C 102(e) as being anticipated by Wallman (U.S. Patent No. 6,338,047 B1).

B. **Second Ground of Rejection for Review on Appeal:**

Appellants respectfully urge the Board to review and reverse the Examiner's second ground of rejection in which the Examiner rejected claims 12, 13, and 34 under 35 U.S.C. § 103(a) as obvious over Wallman in view of knowledge assumed by Official Notice.

7. **ARGUMENT**

As discussed in detail below, the Examiner has improperly rejected the pending claims. Further, the Examiner has misapplied long-standing and binding legal precedents and principles in rejecting the claims under Sections 102 and 103. Accordingly, Appellants respectfully request full and favorable consideration by the Board, as Appellants strongly believe that claims 1-9, 11-16 and 30-37 are currently in condition for allowance.

A. **Ground of Rejection No. 1:**

The Examiner rejected claims 1-9, 11, 14-16, 19-24, 30-33, and 35-37 U.S.C. § 102(e) as being anticipated by Wallman. Because the Examiner rejected each of independent claims 1, 19, and 30 on the basis of the Wallman reference, these independent claims will be discussed together below.

1. **Judicial precedent has clearly established a legal standard for a _prima facie_ anticipation rejection.**

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. _Titanium Metals Corp. v. Banner_, 227 U.S.P.Q. 773 (Fed. Cir. 1985). Thus, for a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. _In re Bond_, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the _identical_ invention "_in as complete detail as contained in the ... claim_" to support a _prima facie_ case of anticipation. _Richardson v. Suzuki Motor Co._, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Appellants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

2.   **The Examiner's rejection of 1, 19, and 30 is improper because the rejection fails to establish a _prima facie_ case of anticipation.**

Independent claim recites:

> 1.   An electronic information system, wherein the electronic information system is accessible electronically via an electronic communication system, wherein the electronic information system is operable to enable a customer to access the electronic information system via the electronic communication system to electronically create _a standing order of a customer specified duration_ for periodic delivery to a specified customer location of a product, good, or service. (Emphasis added.)

Independent claim 19 recites:

> 19.   A computer program stored in a tangible medium, wherein the computer program enables an electronic information system to enable a customer to access the electronic information system and input electronically a desired product, good, or service for periodic delivery to a specified customer location under _a standing order of a customer specified duration_. (Emphasis added.)

Independent claim 30 recites:

> 30.   A system, comprising:
> a memory;
> a computer program stored in the memory,
> a processor coupled to the memory, the processor operating in response to the computer program stored in memory; and
> an electronic communication system coupled to the processor;
> wherein the computer program enables a customer to access the system electronically via the electronic communication device and create _a standing order of a customer specified duration_ for a quantity of a product, good, or service for delivery to a customer specified location by a supplier on a periodic basis. (Emphasis added.)

a. *Wallman Fails To Disclose A Standing Order Of A Customer Specified Duration.*

Appellants submit that the rejection under Section 102 is improper because Wallman does not disclose each and every element recited by the claims. Specifically, independent claims 1, 19 and 30 recite a "standing order of a *customer specified duration.*" (emphasis added). As set forth by the specification, the present technique provides:

> a length of standing order menu 120 to enable a customer to select the *period of time* that the customer desires the standing order to be in effect. The illustrated length of standing order menu 120 is a pull down menu having a number of portions of the length of time the customer desires to have the standing order in place, such as: a month, a quarter, a year, etc.
>
> *See,* Application, paragraphs 46-49; *see also* Fig. 7. (Emphasis added.)

In contrast, Wallman fails to disclose a standing order of *a customer specified duration*. At best, Wallman teaches a standing order that "can be modified at any time in the event the investor decides to shift his or her investment strategy." Wallman, col. 10, lines 41-42. Particularly, Wallman discloses a system intended for "hands off" investors, such that funds may be automatically transferred on a semi-monthly basis. Wallman, col. 10, lines 34-45. Hence, in Wallman funds may be transferred automatically and periodically in accordance with a specified frequency, which suggests minimal investor (customer) intervention and interaction with an investment process. In fact, the system of Wallman is directed towards easing investors' activities by automating a periodic standing order.

This is in stark contrast to the claimed invention which provides more customer options, such as setting a time duration for as standing order, enhancing customer

interaction in an ordering process. The disclosure of Wallman simply lacks the manner in which a customer may specify the duration of the standing order and/or means or methods for providing an investor (customer) to specify the duration of the standing order.

This feature of the invention was recited in original claim 10. In rejecting claim 10 (now cancelled), the Examiner referred to the rejection of claim 14. However, the formulation of neither rejection in any way addresses specifying a duration of an electronically communicated standing order. Again, Wallman has been thoroughly reviewed and found to provide no such teaching.

In view of these deficiencies, the cited reference cannot anticipate claim 1, 19, or 30, or claims dependent therefrom. Accordingly, Appellants respectfully contend that independent claims 1, 19, and 30 and their dependent claims are allowable.

b. Omitted Features of Independent Claims 1, 19, and 30 Regarding a Specified Location.

Independent claims 1, 19, and 30 also recite a product, good, or service delivered "to a customer specified location." Accordingly, the present technique is directed towards standing orders of products, goods, and services, deliverable to actual, tangible, and/or physical locations specified by a customer, requiring tangible and/or physical means for shipment and delivery thereof. Thus, a product, good, or service may be delivered to an actual address, as indicated by Fig. 10, element 166 of the application. Further, as stated by the specification "[t]he quantity to be delivered for each item is displayed in a shipment quantity box 194." Application, page 24, line 23-page 25, line 1. Hence, the system developed and claimed by the Appellants accommodates entry and modification of addresses to which services, goods, and products may be delivered.

In contrast, Wallman provides a service whereby an unlimited number of investors may purchase shares in a mutual fund reflecting the interests and preferences of thousands or millions of different persons. Wallman, col.3, lines 61-65. Such a system provides services over *virtual-not physical* means, merely requiring computer programs and communication protocols implemented by devices, such as computers and modems. Such a manner of providing a service is clearly distinct from that recited in independent claims 1, 19, and 30. Due to the virtual nature of the service and the virtual means for providing it, as taught by Wallman, the cited reference does not and cannot disclose means enabling a customer to specify a physical location to which the service may be sent and/or received.

In view of these deficiencies, the cited reference cannot anticipate claim 1, 19, or 30, or claims dependent therefrom. Accordingly, Appellants respectfully contend that independent claim 1, 19, and 30 and their dependent claims are allowable.

B.   **Ground of Rejection No. 2:**

The Examiner rejected 12, 13, and 34 under 35 U.S.C. § 103(a) as obvious over Wallman in view of knowledge assumed by Official Notice.

Appellants respectfully submit that claims 12, 13, and 34 are allowable based on their respective dependencies from independent claims 1, 19 and 30, because the Examiner's use of Official Notice does not cure the deficiencies described above in regard to Wallman. Accordingly, Appellants request the Board reverse this rejection.

Conclusion

Appellants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner or Board wishes to resolve any other issues by way of a telephone conference, the Examiner or Board is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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8.   **APPENDIX OF CLAIMS ON APPEAL**

Listing of Claims:

1.   An electronic information system, wherein the electronic information system is accessible electronically via an electronic communication system, wherein the electronic information system is operable to enable a customer to access the electronic information system via the electronic communication system to electronically create a standing order of a customer specified duration for periodic delivery to a specified customer location of a product, good, or service.

2.   The system as recited in claim 1, wherein the electronic communication system comprises the Internet.

3.   The system as recited in claim 1, wherein the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system and identify electronically the product, good, or service to be delivered periodically under the standing order.

4.   The system as recited in claim 1, wherein the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system to select the product, good, or service to be delivered periodically under the standing order from a selection of products, goods, or services provided by a supplier.

5.   The system as recited in claim 4, wherein the electronic information system enables the customer to access the electronic information system via the electronic communication system to revise the product, good, or service to be delivered periodically under the standing order.

6.   The system as recited in claim 1, wherein the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system and order a desired quantity of the product, good, or service to be delivered periodically under the standing order.

7.   The system as recited in claim 6, wherein the electronic information system enables the customer to access the electronic information system via the electronic communication system and revise the desired quantity of the product, good, or service to be delivered periodically under the standing order.

8.   The system as recited in claim 1, wherein the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system and establish a desired frequency of delivery of the product, good, or service to be delivered periodically under the standing order.

9.   The system as recited in claim 8, wherein the electronic information system enables the customer to access the electronic information system via the electronic communication system to revise the desired frequency of delivery of the product, good, or service to be delivered periodically under the standing order.

10.   (canceled).

11.   The system as recited in claim 1, comprising:

at least one processor electrically coupled to the electronic communication system; and

a computer program stored in memory, wherein the computer program and processor are operable to enable the electronic information system to communicate electronically with the customer to create the standing order.

12.   The system as recited in claim 11, wherein the electronic information system requires the customer to provide an authorization identifier before enabling the customer to create the standing order.

13.   The system as recited in claim 1, wherein the electronic information system provides the customer accessing the electronic information system with an interactive visual interface.

14.   The system as recited in claim 1, wherein the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system to review a standing order for periodic delivery of a product, good, or service.

15.   The system as recited in claim 1, wherein the electronic information system is operable to enable a supplier to direct the periodic delivery of the product, good, or service.

16.   The system as recited in claim 1, wherein the electronic information system incorporates business rules provided by a supplier for the creation of a standing order, wherein the electronic information system prevents the customer from creating a standing order in violation of the business rules.

17.-18.   (canceled).

19.   A computer program stored in a tangible medium, wherein the computer program enables an electronic information system to enable a customer to access the electronic information system and input electronically a desired product, good, or service for periodic delivery to a specified customer location under a standing order of a customer specified duration.

20. The computer program as recited in claim 19, wherein the computer program enables the electronic information system to enable the customer to access the electronic information system and input electronically a frequency of delivery for the desired product, good, or service.

21. The computer program as recited in claim 19, wherein the computer program enables the electronic information system to enable the customer to access the electronic information system and input electronically a quantity of the desired product, good, or service for periodic delivery under the standing order.

22. The computer program as recited in claim 19, wherein the computer program enables the electronic information system to enable the customer to access the electronic information system and review the standing order.

23. The computer program as recited in claim 19, wherein the computer program enables the electronic information system to enable the customer to access the electronic information system and input revisions to the standing order electronically.

24. The computer program as recited in claim 19, wherein the computer program enables a supplier's business rules to be incorporated into the electronic information system to prevent the electronic information system from creating a standing order in violation of the supplier's business rules.

25.-29. (canceled).

30. A system, comprising:

a memory;

a computer program stored in the memory,

a processor coupled to the memory, the processor operating in response to the computer program stored in memory; and

an electronic communication system coupled to the processor;

wherein the computer program enables a customer to access the system electronically via the electronic communication device and create a standing order of a customer specified duration for a quantity of a product, good, or service for delivery to a customer specified location by a supplier on a periodic basis.

31.   The system as recited in claim 30, wherein the electronic communication system enables the customer to access the system via the Internet.

32.   The system as recited in claim 30, wherein the computer program enables the customer to access the system electronically via the electronic communication system and establish the periodic basis for delivery of the product, good, or service ordered.

33.   The system as recited in claim 30, wherein the computer program enables the customer to access the system electronically via the electronic communication device and establish the periodic basis for delivery of the product, good, or service ordered.

34.   The system as recited in claim 30, wherein the computer program provides the customer accessing the system with an interactive visual interface adapted to direct the customer through a process of ordering the quantity of a product, good, or service for delivery by a supplier on a periodic basis.

35.   The system as recited in claim 30, wherein the system is operable to enable the customer to access electronically via the electronic communication system to change the quantity of a product, good, or service for delivery by a supplier on a periodic basis.

36.   The system as recited in claim 35, wherein the system is operable to enable the customer to access electronically via the electronic communication device to change the periodic basis for delivery of the quantity of a product, good, or service.

37.   The system as recited in claim 30, wherein a supplier's rules for ordering products, goods, or services, are stored in memory, further wherein the system prevents the customer from ordering the quantity of a product, good, or service in violation of the supplier's rules.

38.-54. (canceled).

9.   **APPENDIX OF EVIDENCE**

None.

10.   **<u>APPENDIX OF RELATED PROCEEDINGS</u>**

None.